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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,583	05/03/2001	Wolfgang Matthes	A-2820	8707
24131	7590	09/20/2005	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/848,583

Applicant(s)

MATTHES ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12 and 13 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Prosecution is reopened in view of new grounds of rejection that have come to the attention of the examiner.

#### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “electric cam disk”, of claim 5, “machine control unit”, of claim 6, “human-machine interface”, of claim 7, and the “gatherer-stitcher”, of claims 12 and 13, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito (4,922,773) (previously listed by the examiner on form PTO-892 filed 13 March 2003).

In regards to claim 1, Ito discloses the same invention including a transport device (53) and a first drive for driving the transport device (57), a stroke device for moving the knives for performing the trimming of the margins (18), a second drive for driving for driving the stroke device (20), the first drive and the second drive being separate (57 and 20), and both drives being connected to another via a control system (Fig. 6). In regards to claims 2 and 3, Ito discloses the cutting device is capable of trimming margins of joined/stitched-together sheets of paper (7). In regards to claim 4, Ito discloses the control system includes a first and second control unit (Fig. 6), the first drive being linked to the first control unit (85), a second drive being linked to the second control unit (81), and a connection linking the first control unit to the second control unit (73). In regards to claim 5, Ito discloses the control units enable a setting of a speed profile (85 and 81 (Each of the control units independently control a drive to drive its

Art Unit: 3724

respective item at a certain speed. Since the controllers independently control the drives and the certain speed at which they work, the control units, therefore, enable a separate setting of a speed profile). In regards to claims 6 and 7, Ito discloses the first drive is connected by the first control unit and the second drive by the second control unit to a machine control unit (74) and the machine control unit had a human-machine interface (71 and 72). In regards to claim 10, the drives are motors (57 and 20) and at least one of the control units has a memory-programmed controller (75 and 76).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Cannon et al. (4,553,080). Ito discloses the invention including the first and second drives are motors (57 and 20).

However, Ito fails to disclose position transducers connected to the first control unit and drive and to the second control unit and drive. Cannon et al teaches that it is old and well known to exchange encoders for position transducers (Background of the Invention). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Ito with position transducers instead of encoders, as taught by Cannon et al., to provide more a less complex and cheaper apparatus.

Art Unit: 3724

6. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleineberg et al. (2,922,171) in view of Ito. Kleineberg et al. disclose the invention, with regards to claim 12, including a gatherer-stitcher (10 and 11) having a cutting device for trimming (13), a transport device (12) and a first drive for driving the transport device (15), a stroke device for moving the knives for performing the trimming of the margins (24), a second drive for driving for driving the stroke device (22), and the first drive and the second drive being separate (Column 3 lines 32-35). In regards to claim 13, Kleineberg et al. disclose the cutting device is capable of trimming margins of stitched-together sheets of paper (10, 11, and 13).

However, Kleineberg et al. fail to disclose that both of the drives are connected to another via a control system. Ito teaches two independent drives of a trimming apparatus connected to another via a control system (Fig. 6). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kleineberg et al. with a control system connecting both independent drives, as taught by Ito, to allow a control system, rather than a human, to control both independent parts of the apparatus to allow for maximum output.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-10, 12, and 13 have been considered but are moot in view of the new ground(s) of rejection. Also, the examiner requests an explanation of how the apparatus performs the stroke to moves the blades. The explanation need not be put in the specification but just in the "remarks" section of the next response. This request has been made because the examiner is still very

Art Unit: 3724

unclear how the knives move and an explanation will allow for a more competent examination.

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP  
September 12, 2005

  
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